

REMARKS

Claims 1-25 are pending. Claims 1, 20 and 24 are amended.

No new matter has been added. Support for the amendments to the claims may be found in paragraphs 0031, 0046, and 0051-0053 of the published application (2005/0043967), for example.

Reconsideration of the outstanding rejections in the present application are requested based on the following remarks.¹

THE MAY 20, 2004 INFORMATION DISCLOSURE STATEMENT (IDS)

Applicant filed an Information Disclosure Statement (IDS) on May 20, 2004. However, Applicant has not received an initialed copy of such filing. Applicant requests the Examiner to initial such filing and forward to Applicant, so as to document consideration of such cited art.

REJECTION OF CLAIMS 1-7 UNDER 35 U.S.C. § 102(e)

Claims 1-7 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,986,568 to Suzuki *et al.* ("Suzuki"). *Office Action*, p. 3. This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. As stated in MPEP § 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The features of claim 1 are set forth above. Claim 1, as well as claims 20 and 24 are hereby amended, regarding the particulars of the data input portion, to further distinguish over the applied art.

The Office Action relies on column 9, lines 63-67, column 10, lines 1-18, and figure 1 of Suzuki for disclosing all of the elements of claim 1. As discussed in Applicant’s prior Response, the asserted sections of the Suzuki specification, for example, recite that:

When the visiting nurse 1 visits a patient's house, the visiting nurse 1 inputs various information items to the carried PDA 2. When the visiting nurse 1 visits the patient's house and gives care to the patient, the visiting nurse 1 inputs various information items to the carried PDA 2 in the patient's house and/or thereafter, another place such as the nurse's house. The visiting nurse 1 returns home after this visit. Thereafter, the visiting nurse 1 transfers the visiting information previously inputted to the PDA 2 to the computer 5 from the PDA 2 by a predetermined data transfer means 6.

The information transferred to the computer 5 is transferred to the server device 3 by the above-mentioned predetermined data communication means 4.

The server device 3 adds the received data to a data base (not shown) and makes and transfers a file which should be transferred to follow instructions.

When data is downloaded from the server device 3 to the PDA 2, required data is temporarily downloaded to the computer 5 from the server device 3 through the predetermined data communication means 4 and are transferred to the PDA 2 from the computer 5 by the data transfer means 6.

Suzuki, C. 9, l. 63 - C. 10, l. 18. As recited in this asserted section of Suzuki, “the visiting nurse 1 inputs various information items to the carried PDA 2.” Suzuki further recites that “This operation supporting system has PDA (a portable information communication terminal) 2 carried by each visiting nurse ...” *Suzuki*, C. 8, ll. 64-66. As is clearly shown

by these recited sections of Suzuki, the PDA device is carried by the nurse and is not disposed in the home of the claimant.

Patentability is based on the claimed invention. However, for purposes of illustration, exemplary support for the caregiver interfacing with a data input portion, which is disposed in the home of the claimant, as recited in amended claim 1 is found in several places within the specification of the present application. For example, *inter alia*, “In step 200, installation of the data input portion is performed for new recipients in the program. That is, a data input portion 30 is installed into the claimant’s home 12.” *US Patent Application 2005/0043967*, para. [0045]. The specification further recites that, “In step 400, the process performs a data transfer from the data input portion 30 in the claimants home 12 to the servicing entity 50.” *Id.* at para. [0046]. The specification further recites that, “In step 240, a suitable person installs the data input portion in the home 12 of the claimant.... The data input portion 30 might be mounted on a wall or as a table top device, for example.” *Id.* at para. [0052].

Claim 1, by this response, is further amended to more clearly distinguish over the applied art by further reciting the particulars of the data input portion. In particular, claim 1 is amended to recite:

disposing a data input portion in the home of the claimant such that the data input portion is disposed in the home of the claimant continuously over a period of time inclusive of a plurality of visits of the caregiver, and such that over such period of time the data input portion is retained by the claimant in the home of the claimant and not retained by the caregiver, and during such period of time data is collected by the data input portion by interfacing with the caregiver, and such data is transferred from the data input portion, while disposed in the claimant’s house, to the servicing entity in accord with the relationship of the claimant with a servicing entity, and during such period of time the data input portion is used to document only care of the single claimant;

Relatedly, in Applicant's prior Response, Applicant asserted that Suzuki does not disclose "the caregiver interfacing with a data input portion, which is disposed in the home of the claimant" as was previously recited in claim 1 of the present application. Rather, in Suzuki the nurse carries a PDA for entering information. By having the data input portion disposed in the house of the claimant, as claimed, the caregiver is forced to enter the data into the data input portion while in the home of the claimant with the data input portion transmitting the collected data to the servicing entity. By inputting the claimed first data set prior to providing the service and again interfacing with the data input portion after providing the service, the caregiver may document the services performed during the time the caregiver was at the home of the claimant. *Id.* at para. [0059]. Hence, Suzuki does not disclose each and every element recited in claim 1.

Claim 1 is hereby amended to further distinguish over the applied art based on such distinguishing feature.

In response to Applicant's prior assertions, on page 2 of the pending Office Action, the Examiner sets forth "Response to Amendments/Arguments." Specifically, the Office Action sets forth:

Applicant's arguments filed 10-17-2008 have been fully considered but they are not persuasive. Examiner disagrees with applicant's arguments. With respect to claim 1 Applicant argues that Suzuki does not teach a method for documenting home care services for providing reimbursement in the situation where a claimant has a relationship with a servicing entity, the claimant being cared for by a caregiver has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

However, Applicant respectfully submits that such response, as set forth in the pending Office Action, is simply not dispositive as to Applicant's arguments (set forth above) relating to the data input portion. Notwithstanding such, Applicant has further amended claim 1, as well as independent claims 20 and 24, to expedite prosecution. The teachings of Suzuki relating to use of a PDA by the visiting nurse clearly fall short of teaching or suggesting the features as now recited in claim 1.

For at least these reasons, independent claim 1, as well as dependent claims 2-7, are patentable over Suzuki. Therefore, the undersigned representative will not address the arguments with respect to claims 2-7 and reserves the right to address these arguments at a later time. Accordingly, it is respectfully requested that the rejection of claims 1-7 under 35 U.S.C. §102(e) be reconsidered and withdrawn.

REJECTION OF CLAIMS 8, 9, 13-16, 18, & 19 UNDER 35 U.S.C. § 103(a)

Claims 8, 9, 13-16, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki. *Office Action*, p. 5. This rejection is traversed. Since claims 8, 9, 13-16, 18, and 19 are dependent on allowable independent claim 1, dependent claims 8, 9, 13-16, 18, and 19 are allowable as well. Therefore, the undersigned representative will not address the arguments with respect to claims 8, 9, 13-16, 18, and 19 and reserves the right to address these arguments at a later time. Withdrawal of the rejection of claims 8, 9, 13-16, 18, and 19 is requested.

REJECTION OF CLAIMS 10, 12, & 24 UNDER 35 U.S.C. § 103(a)

Claims 10, 12, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of U.S. Patent 7,107,285 to von Kaenal *et al.* ("von Kaenal"). *Office Action*, p. 7. This rejection is traversed. Since claims 10 and 12 are

dependent on allowable independent claim 1, dependent claims 10 and 12 are allowable as well. **Moreover, the rejection is inappropriate.** Claim 12 is dependent on claim 11 which stands rejected as being unpatentable over Suzuki in view of Guyan (see below). If the parent claim of claim 12, is rejected in view of Suzuki and Guyan, then, at a minimum, the same references must be used to reject claim 12 as well. Please note that if claim 12 is rejected in a subsequent Office Action using different references or additional references then asserted in the current Office Action, the subsequent Office Action should be a Non-Final Office Action.

Regarding independent claim 24, since claim 24 contains similar limitations as argued above with respect to independent claim 1, e.g., a data input portion disposed in the home of the claimant, and since von Kaenal does not cure the deficiencies of Suzuki, claim 24 is allowable for the same reasons asserted above with respect to claim 1.

Therefore, the undersigned representative will not address the arguments with respect to claims 10, 12, and 24 and reserves the right to address these arguments at a later time. Withdrawal of the rejection of claims 10, 12, and 24 is requested.

REJECTION OF CLAIMS 11 & 20-23 UNDER 35 U.S.C. § 103(a)

Claims 11 and 20-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of U.S. Patent 7,124,112 to Guyan *et al.* ("Guyan"). *Office Action*, p. 7. This rejection is traversed. Since claim 11 is dependent on allowable independent claim 1, dependent claim 11 is allowable as well.

Regarding independent claim 20, since claim 20 contains similar limitations as argued above with respect to independent claim 1, e.g., a data input portion disposed in the home of the claimant, and since Guyan does not cure the deficiencies of Suzuki, claim 20,

as well as dependent claims 21-24, are allowable for the same reasons asserted above with respect to claim 1.

Therefore, the undersigned representative will not address the arguments with respect to claims 11 and 20-23 and reserves the right to address these arguments at a later time. Withdrawal of the rejection of claims 11 and 20-23 is requested.

REJECTION OF CLAIM 17 UNDER 35 U.S.C. § 103(a)

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of U.S. Patent 5,357,427 to Langen et al. ("Langen"). *Office Action*, p. 10. This rejection is traversed. Since claim 17 is dependent on allowable independent claim 1 and since Langen does not cure the deficiencies of Suzuki with respect to claim 1, dependent claim 17 is allowable as well. Therefore, the undersigned representative will not address the arguments with respect to claim 17 and reserves the right to address these arguments at a later time. Withdrawal of the rejection of claim 17 is requested.

REJECTION OF CLAIM 25 UNDER 35 U.S.C. § 103(a)

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of von Kaenal and in view of Guyan. *Office Action*, p. 11. This rejection is traversed. Since claim 25 is dependent on allowable independent claim 24 and since the applied art does not cure the deficiencies of Suzuki with respect to claim 24, dependent claim 25 is allowable as well. Therefore, the undersigned representative will not address the arguments with respect to claim 25 and reserves the right to address these arguments at a later time. Withdrawal of the rejection of claim 25 is requested.

CONCLUSION


The foregoing is submitted as a full and complete Response to the pending Office Action.. Favorable consideration of the claims is requested. If the Examiner believes any informalities remain in the application which may be corrected by Examiner's Amendment, or if there are any other issues which may be resolved by telephone interview, a telephone call to the undersigned attorney at (703)714-7449 is respectfully solicited.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-0206, and please credit any excess fees to such deposit account.

Respectfully submitted,

Dated: JUNE 2, 2009

HUNTON & WILLIAMS LLP
1751 Pinnacle Drive, Suite 1700
McLean, VA 22102
Phone 703-714-7400
Fax 703-714-7410



James R. Miner
Attorney for Applicant
Registration No. 40,444

JRM/PTO/06022009/